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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,325	06/11/2001	Yoshiki Nakagawa	1581/00255	8453

7590

09/10/2002

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EXAMINER

LIPMAN, BERNARD

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,325

Applicant(s)

NAKAGAWA ET AL.

Examiner

Bernard Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 10-22, 24, 28-40 and 44-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The present application contains four distinct inventions, each drawn to a different polymeric entity or method of making said polymeric entity and each with different structural elements which are distinct and mutually exclusive one from the other. The inventions are: Group I, claims 1-15, Group II, claims 16-18, Group III, claims 19-34 and Group IV, claims 35-55. Each of these groups of claims besides being distinct in structure are also classified in various different classifications. The four inventions do not represent a single special technical feature insofar as they are all mutually exclusive one from the other and each contains its own special technical feature with regard to its functionality. The claims are, therefore, properly restricted as delineated above.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Claims 1-4, 6, 10-22, 24, 28-40 and 44-46 are rejected under 35 U.S.C. § 112, both first and second paragraphs as delineated below. Applicants have provided a method of claiming specific functional polymers using specific catalysts to polymerize the polymers and thereafter functionalizing the polymers. Nowhere, however, are the claims as rejected representative of these teachings insofar as they read on a multitude of potential polymers with functionalities pendant

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therefrom with any connecting groups. These claims are, therefore, broader than one of ordinary skill in the art is enabled, by the disclosure, to practice the invention, since they do not include the limitations of either type of polymerization used or resultant features of the polymers from the type of polymerization as disclosed.

Claims 10, 11, 16, 28, 33 and 44 are further rejected as indefinite. Claims contain the terminology "obtainable" which is not definitive as to the process by which the claims are obtained insofar as they could be, from this terminology, produced by other methods in conjunction with those specified in the claims. The proper language to make these claims definite is the use of the term "obtained". Claim 16 is further indefinite in that it contradicts claim 10 from which it depends. Claim 10 requires that the polymer produced have a silanol group. Claim 16 requires that the polymer have "no silanol group". This is a contradiction between the two claims and renders them indefinite.

The rejections under 35 U.S.C. § 112 are presented herein in order to expedite prosecution of this application. Consideration of the prior art is held in abeyance pending resolution of the restriction requirement herein.

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September 6, 2002



BERNARD LIPMAN
PRIMARY EXAMINER